

REMARKS/ARGUMENTS

The Amendments set out above and the following remarks are responsive to the points raised by the Office Action dated February 8, 2008, and discussed during the interview with Examiners Carter and Battula on January 29, 2008. In view of the amendments set out above and the following remarks, reconsideration is respectfully requested.

As an initial point, Applicant's representative greatly appreciate the courtesy shown her by Examiners Carter and Battula, and further appreciate their careful consideration of the arguments presented during the interview.

The Pending Claims

Claim 13 is added, so that claims 1-13 are now pending. Claims 1 and 12 are amended, and claim 13 is added, to describe the invention more clearly. No new matter is added, and the basis for the amended claim language may be found within the specification, claims, and drawings. Amended claim 1 is supported at, for example, page 2, lines 19-22 of the specification. Amended claim 12 is supported at, for example, page 2, lines 4-6 of the specification. New claim 13 is supported at, for example, page 2, lines 27-32 of the specification.

The Office Action

Claims 1, 2, 4, 5, 7, 9, and 11 were rejected under 35 U.S.C. § 103 as unpatentable over EP 0018004 to Eaton (hereinafter, "Eaton") in view of FR 2,792,573 to Gallot (hereinafter, "Gallot").

Claims 3, 6, 8, 10, and 12 were rejected under 35 U.S.C. § 103 as unpatentable over Eaton in view of Gallot and DE 200707028 to Herlitz (hereinafter, "Herlitz").

Each of these rejections is separately and respectfully traversed.

The obviousness rejection cannot be maintained for several reasons, explained more fully below. First, the cited references fail to teach or suggest the claimed invention as a whole. Second, the combination of Eaton and Gallot is improper because it would render the device of Eaton inoperable for its intended purpose. Third, one of ordinary skill in the art

would not be motivated to combine Eaton, used for storing sewing threads, with Gallot, used for storing documents.

As an initial point, the amended claims can no longer be considered product-by-process claims. The Office Action appears to allege that the claim limitation regarding how the pages are stored by unfolding the flaps away from the interior side of the first sheet and notebook pages stored under the first and second flaps amounts to a product-by-process limitation. The Office Action further states that the patentability of the product does not depend on its method of production.

Independent claim 1 is amended to phrase the limitation in structural, rather than process, terms. Because independent claims 1, 12, and 13 each define the invention in terms of structure, it is respectfully submitted that the independent claims can no longer be considered product-by-process claims. Thus, all limitations of the independent claims must be considered in determining the patentability of these device claims.

The Office Action alleges that it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Eaton with all flaps being movable and folding on top of another in order to allow for the flaps to accommodate stacks of sheets having different sizes.

A proper obviousness evaluation requires that the Office consider the claimed invention “as a whole” (MPEP § 2142). Neither Eaton, Gallot, or Herlitz teaches or suggests the claimed invention “as a whole,” either alone or in combination with each other. Accordingly, the obviousness rejections cannot be maintained.

Properly considering the claims as a whole shows that the fundamental structural concept in the claimed filing folder includes, first, that the notebook pages are *securely* connected to the binding and, second, that each of the first and second flaps has a first position folded one on top of the other towards an interior side of the first sheet, and each has a second position folded away from an interior side of the first sheet, wherein the notebook pages are in storage under the first and second flaps that are both in the first position and the notebook pages are fully accessible from the first and second flaps that are both in the second position, as claimed.

As explained in the specification and in earlier remarks, this structure provides the advantage that a user can store the notebook pages at a particular location to easily resort to the same notebook page at a later time, *while* those notebook pages are still securely attached to the binding. The continued attachment to the binding prevents loss of the pages. The claimed structure has the further advantage of making it possible to alternately store and access the notebook pages without wrinkling, folding, or otherwise structurally altering any of the individual notebook pages *while they are still securely bound to the binding*. Thus, the notebook pages in the claimed filing folder are kept neat and organized whether in the stored position or in the accessible position.

Eaton and Gallot fail to teach or even remotely suggest the structure of the claimed filing folder. None of the cited references address the problem of organizing, storing, and accessing notebook pages that are *securely connected to the binding*, as claimed. Neither Eaton nor Gallot even disclose notebook pages securely connected to the binding. Without disclosing notebook pages securely connected to the binding that are stored and accessed by virtue of the claimed relative positions of the flaps, Eaton and Gallot fall short of rendering the presently claimed invention obvious.

The Office Action correctly acknowledges that Eaton does not disclose notebook pages securely connected to the binding, and the first and second flaps being foldable towards and away from an interior side of the first sheet for storing and accessing notebook pages that are, respectively, securely linked to the binding, by folding the first and second flaps successively, one on top of the other, toward the interior side of the first sheet, with the notebook pages under the first and second flaps folded towards the interior side of the first sheet, and by unfolding the flaps away from the interior side of the first sheet and notebook pages stored under the first and second flaps.

The combination of Eaton with Gallot, alleged by the Office Action, is improper because the combination would render Eaton inoperable for its intended use. The pocket formed by the tab 3 and the holding means 8 is essential to the intended operation of the device of Eaton, which is to hold the ends of pieces of thread neatly in the pocket and to avoid intermixing the threads. Modifying the device of Eaton to have the flaps of Gallot would remove the pocket of Eaton so that the device of Eaton would no longer function

properly to hold the ends of the threads in place against the tab 3. Accordingly, modifying Eaton in view of Gallot would render the device of Eaton inoperable for its intended purpose. Accordingly, the combination of Eaton and Gallot is improper and the obviousness rejection cannot be maintained.

Additionally, the pocket of Eaton's device is designed to firmly hold the ends of threads, which are not very thick. Thus, it would be difficult for a user to place notebook pages in the pocket of Eaton 8. Moreover, the pocket of Eaton does not appear to be large enough to accommodate very many notebook pages. Also, any few papers stored within the pocket would be damaged when the holding device 8 and the tab 3 are folded over because the sheets would be held by their ends in the pocket 8. Accordingly, Eaton's device is not adapted to store a stack of sheets of paper securely attached to a binding mechanism. Thus, the present claims are patentable over Eaton and Gallot.

Moreover, one of ordinary skill in the paper storage art would not be motivated to combine Gallot and Eaton. Eaton is concerned with an apparatus for storage threads used in sewing, while Gallot is concerned with a folder for holding documents. Eaton, therefore, is in an entirely different field of endeavor from the paper storage field of Gallot. Additionally, Eaton and Gallot disclose entirely different apparatuses used to solve entirely different problems. Thus, one of ordinary skill in the art would not be motivated to combine Eaton and Gallot, and the obviousness rejection cannot be maintained.

Independent claims 12 and 13 are also patentable for the reasons set forth above. New independent claim 13 is also allowable, not only for the reasons set forth above, but also because it defines additional limitations not taught by any of the cited references. Claim 13 defines a filing folder in which a first portion of the notebook pages are in storage under the first and second flaps that are in the first position and a second portion of the notebook pages are accessible and are positioned above the first portion of the notebook pages and above the first and second flaps that are both in the first position. This structural limitation provides an indexing feature that enables a user to advantageously divide and partition the notebook pages into multiple portions and separately organize, store and access the multiple portions of notebook pages. Such a structural feature is not taught or suggested in any of the cited references. Accordingly, independent claim 13 is also patentable over the cited references.

The filing folder of the present invention is patentably distinct from the devices of Eaton and Gallot for the reasons set forth above. Herlitz does not cure the deficiencies of Eaton and Gallot. Accordingly, the combination also fails to render the present claims obvious.

Because the independent claims are allowable for the reasons set forth above, the dependent claims are also allowable because they depend from patentable independent claims.

Conclusion

Applicants respectfully submit that the patent application is in condition for allowance. If, in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is invited to call the undersigned attorney.

Respectfully submitted,

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